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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Timothy J. Cooney

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INTERNATIONAL ENGINE INTELLECTUAL PROPERTY COMPANY

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EXAMINER

KAZIMI, HANI M

ART UNIT

PAPER NUMBER

3691

NOTIFICATION DATE

DELIVERY MODE

01/27/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptinfo@navistar.com

Office Action Summary	Application No. 09/832,603	Applicant(s) COONEY ET AL.	
	Examiner Hani Kazimi	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's request for consideration filed on June 20, 2008. Claims 21 and 22 are pending in the application.

Response to Applicant's Amendment

2. Applicants' request for consideration filed on June 20, 2008 have been fully considered, and discussed in the next section below or within the following rejections under 35 U.S.C. § 102. Applicants' request for allowance is respectfully denied.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Dudle et al US Pat. No. 5,570,291 A.

Claims 21 and 22, Dudle discloses a method for enabling a potential purchaser of a future product that is to be manufactured by a potential supplier and sold to the purchaser in the future to negotiate a mutually agreeable price at which the product will be sold by the supplier to the purchaser (abstract, column 14, lines 9-46, and figs. 28-36), wherein:

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the purchaser links its own sources of data relating to the design and manufacture of the product and to shipment of the product from the supplier to a point-of-use by the purchaser through an interactive computer system that is accessible to purchaser's design, manufacturing, and purchasing staffs (column 10, line 51 thru column 11, line 45);

the purchaser utilizes the interactive computer system to process inputs from those staffs and data from purchaser's data sources and to develop from those inputs and data, additional data that defines a design for the product, a process for manufacturing the product, shipment from the supplier to the purchaser's point-of-use, and a cost that the purchaser expects the supplier to have incurred in manufacturing the product and having the product delivered to the purchaser's point-of-use (column 10, line 51 thru column 11, line 45);

the purchaser transmits the additional data to the supplier; and

the purchaser and the supplier utilize the transmitted data to negotiate toward a mutually agreeable price at which the supplier will sell the product to the purchaser and the purchaser will buy the product from the supplier (column 6, lines 44-67, column 14, lines 9-46, and figs. 28-36). ;

wherein, the supplier utilizes the transmitted additional data to create a counterproposal to the purchaser containing one or more modifications of the transmitted data based on the data from the supplier's own data sources; the supplier transmits the counterproposal to the purchaser, and the counterproposal is utilized by the purchaser and supplier to negotiate toward a mutually agreeable price at which the

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supplier will sell the product to the purchaser and the purchaser will buy the product from the supplier (column 2, lines 47-57, column 6, lines 44-67, column 14, lines 9-46, and figs. 28-36).

Response to Arguments

4. Applicant's arguments with respect to claims 21 and 22 filed on June 20, 2008 have been fully considered but are not persuasive.

Applicant argues in substance that Dudle does not anticipate Claims 21 and 22 because, "the purchaser not the supplier utilizes the interactive computer system to process inputs from those staffs and data from purchaser's data sources and to develop from those inputs and data, additional data that defines a design for the product, a process for manufacturing the product, shipment from the supplier to the purchaser's point-of-use, and a cost that the purchaser expects the supplier to have incurred in manufacturing the product and having the product delivered to the purchaser's point-of-use".

The supplier utilizes the transmitted additional data to create a counterproposal to the purchaser containing one or more modifications of the transmitted data based on the data from the supplier's own data sources; the supplier transmits the counterproposal to the purchaser; and the counterproposal is utilized by the purchaser and supplier to negotiate toward a mutually agreeable price at which the supplier will

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sell the product to the purchaser and the purchaser will buy the product from the supplier?

Dudle fails to disclose any negotiating or negotiations between purchaser and supplier.

In response to the above arguments:

The Examiner respectfully disagrees with Applicant's assertion. In response to Applicant's argument that Dudle does not anticipate Claims 21 and 22.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Claims 21 and 22 describe an intended use (underlined above) and does not require any particular structure. The intended use limitations are not positively claimed and therefore are not given any patentable weight. The Examiner maintains the rejection of claims 21 and 22 as being anticipated by Dudle.

In response to Applicant's argument, that Dudle fails to disclose any negotiating or negotiations between the purchaser and the supplier. The negotiating language is intended use and is not positively claimed. However, even if applicant positively claim the negotiations between purchaser and supplier, Dudle teaches the price agreement between the two. Dudle states, "...In accordance with still another aspect of the present invention, custom price matrices are created to generate customer-specific estimates in

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accordance with a contract agreement between the manufacturer and the customer...” and “...With reference to the affirmative branch of decision block 145 and block 147, the Estimating subsystem 90 can generate an estimate for an item that is to be priced in accordance with a contractual agreement between the customer and the corporation. As will be described below in connection with FIGS. 28 through 36, contract price matrices can be generated to reflect contractual terms. Contract price matrices can be created as a subset of the standard or generic price matrices used to generate estimates for non-contract items. The generic price matrices can be used for estimating any customers' orders. The generic price matrices are generally based upon raw material prices, equipment and other factors that affect actual cost to fulfill an order. A custom price matrix, on the other hand, can include contractual concessions between the forms manufacturer and the customer resulting in prices below, for example, the standard prices, i.e., discounts for the volume of business the customer brings to the manufacturer. An advantage of using contract price matrices is that they support contract proposal generation by corporate personnel in, for example, a Contract Administration division of the corporation by developing matrices of multiple items. This is particularly useful when the corporation is offering concessions to a customer with a large number of existing forms. The contract matrices eliminate the need to perform an estimate for each form for contract proposal purposes. Since contract terms are stored at the corporate office, corporate personnel can perform contract profit and other types of analysis, and provide contract customers with a common reference for pricing...”

The invention is broadly claimed, and the cited reference meets the scope of the claimed limitations.

Conclusion

5. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Hani M. Kazimi/

Primary Examiner, Art Unit 3691